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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,450	07/27/2001	Jon C. Pergande	WG0096	8745

7590 09/16/2002

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EXAMINER

DUONG, THANH P

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,450

Applicant(s)

PERGANDE ET AL.

Examiner

Tom P Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1- 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

During a telephone conversation with Mr. Terence P. O'Brien on 8/29/02 a provisional election was made without traverse to prosecute the invention of I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a golf club head having a resilient insert assembly, classified in class 473, subclass 342.
 - II. Claims 19-34, drawn to a vibration dampener of unitary construction, classified in class 473, subclass 332.
 - III. Claims 35-42, drawn to a golf club vibration dampening and sound attenuation system comprising: a resilient insert assembly and a dampener and a grip, classified in class 473, subclass 342, 332, 300, and 304.
 - IV. Claim 43, drawn to a tool for installing a dampener within a shaft, classified in class 81, subclass unknown.
2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as the insert in the golf

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club head is distinct invention from the vibration dampener but are useable together in a golf club . See MPEP § 806.05(d).

3. Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the golf club with an insert does not require a vibration dampener to be patentable. The subcombination has separate utility such as reducing the vibration in the golf club head but not necessarily in the shaft.

4. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the golf club with a vibration dampener in the shaft does not require an insert to be patentable. The subcombination has separate utility such as reducing the vibration in the shaft but not necessarily in the club head.

5. Inventions IV and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and

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materially different apparatus (MPEP § 806.05(g)). In this case, the tool can be use to fasten or insert other product such as bolts, o-rings, and nuts other than a dampener.

The inventions are distinct, each from the other because of the following reasons:

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III, and IV restriction for examination purposes as indicated is proper.
8. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.
9. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group IV, restriction for examination purposes as indicated is proper.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutin (5,586,947). With respect to claims 1 and 2, Hutin discloses a golf club head (Fig. 5) comprising of a front wall, a sole portion (6) having a rear cavity (7) and recess, a vibration damper 10. The vibration damper 10 is functionally equivalent to the a resilient insert as claimed. Hutin does not disclose expressly the insert has a 75 Shore D hardness but it is inherent that the vibration damper of Hutin has sufficient hardness to provide adequate shock absorption. In addition, it is obvious in view of Hutin to one having ordinary skill in the art such hardness value or any given hardness value can be obtained thru routine optimization, *In re Boesch*, 205 USPQ 215 (CCPA 1980). With respect to claims 3, 4, 7, and 8, Hutin shows on Figure 3 the vibration damper 10 consist of rigid plate 11 and a visco-elastic sheet 12. It appears that the vibration damper 10 structure provides the same function and shock adsorption performance as the insert having a first and second inserts as claimed. Having a one piece-insert or insert assembly consists of a first insert and second insert is a matter of design choice to one having ordinary skill in the art. In addition, it would have been obvious to one having ordinary skill in the art to make the vibration

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damper 10 (insert) into to plural parts such as multiple inserts assembly as a matter of obvious engineering choice. *In re Larson*, 144 USPQ 347 (CCPA 1965); *In re Lockart*, 90 USPQ 214 (CCPA 1951). With respect to claims 5 and 6, if the insert was made into plural parts like insert assembly as claimed than it would have been obvious to one of ordinary skill in the art that the insert assembly could be fabricated with the first insert material being different than the second insert material. If the first and second inserts are made of different material, than it would have been obvious that hardness of the first and second inserts are also different. With respect to claim 9, Hutin discloses that the vibration damper 10 can have various shapes such as circular, elliptical, oval or polygonal (Col. 4, lines 34-37) and a change in shape is also an obvious matter of design choice to one skill in the art. With respect to claim 10, Hutin shows on Figure 8 that the vibration damper 10 (insert) is affixed at the sole portion of the lower region of rear side. With respect to claim 11, Hutin disclose the visco-elastic material is made of butyl rubbers and synthetic elastomers. (Col. 2, lines 22-25). With respect to claims 12, Hutin shows a vibration damper 10 consisting of a visco-elastic material (12) adhering to the rear surface of the iron and the rigid plate is laminated on top of the visco-elastic material 12 to protect the visco-elastic material 12. (Figure 4, and Col. 4, lines 21-23). Figure 3 shows the engraved marking such as lettering or logo either shown thru the rigid plate or engraved directly on top of the rigid plate. This rigid plate is functionally equivalent to the cap as claimed. Claims 13, 14, 15, 16, 17, and 18 recite limitations similar to claims 1, 7, 8, 9, 11, and 12, respectively; thus these claims are rejected for the same reasons as described above.

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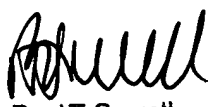
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7768 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-4148.

Tom Duong
September 7, 2002


Paul T. Sewell
Supervisory Patent Examiner
Group 3700